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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,976	05/22/2001	David Pacifici	A32137A	1995

7590 07/22/2002

BAKER BOTTS LLP
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NEW YORK, NY 10112-4498

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 07/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,976

Applicant(s)

PACIFICI, DAVID

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 10-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

- ✓ 1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the band being wounded (claim 13) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Note: Even if the spelling of "wounded" should be "wound", this limitation is not disclosed in the drawings.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- ✓ 3. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, lines 2-3, it is not clear what is meant by the term "destined" in relationship to the claim limitations. How does an adhesive have a "destiny"?

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-7 and 10-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corlew et al. ('187) in view of Delcuve et al. ('629).

Corlew et al. disclose a sheet for binding to one or more sheets and the method thereof including a sheet (11), an adhesive strip (15- self-stick adhesive) along at least one of its edges (lateral edge), a paper backing strip (16) releasably placed on the adhesive; the paper backing strip is released from the adhesive so that the sheet may be attached to a page in the magazine.

Adhesives having permanent (pressure-sensitive) and temporary (releasable or repositional) properties are well-known in the art. Even though Corlew recognizes the use of a releasable adhesive for repositioning the sheet in the magazine, it would have been obvious to provide a permanent adhesive on the sheet should the user desire the sheet to permanently remain in a particular position.

Regarding the backing being larger than the adhesive (claim 6), it would have been an obvious matter of design choice to modify the size of the backing in relation to the adhesive, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). In this particular case,

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Corlew discloses manually pulling the backing off of the adhesive. Changing the size of the backing by extending the backing beyond the adhesive would further enable the user to remove the backing from the adhesive.

Regarding claim 15, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any number of adhesive bands on the sheet at a desired location (front or back of the sheet), since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Furthermore, applicant has failed to disclose that the number of adhesive bands and the location of the adhesive bands is critical to the invention.

Regarding claim 16, the method of applying the band to the sheet does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claims 7 and 19-21, the method binding the sheets together is inherently disclosed in the above rejections.

Corlew disclose the claimed invention except for the adhesive strip having a silicone band that is wound. Providing a silicone band as a release liner for an adhesive is well-known in the art. Delcuve et al. disclose double-sided silicone coated liners adapted for self-wound tapes for coating adhesives. The silicone paper has an advantageous

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elongation/shrinkage relationship as compared to glassine-type and film liners.

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Corlew's invention to provide the paper backing having a silicone band, as taught by Delcuve, to provide a liner having good dimensional stability at an attractive cost (col. 1, lines 63-67).

Response to Arguments

6. Applicant's arguments filed May 6, 2002 have been fully considered but they are not persuasive.

Drawings

Regarding the drawings, the drawings continue to be objected to since the claimed limitation of a band that is wound (i.e. coiled about itself) has not been disclosed in the drawings. While the specification may contain the abovementioned limitation, the drawings are required to show every feature of the invention that is claimed.

35 U.S.C. 112, 2nd paragraph rejections

Regarding claim 14, it is not clear what applicant means by "destined". It is not clear how adhesive can be "destined" to perform a particular operation. Therefore, this rejection is maintained.

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Art Rejections under 35 U.S.C. 103

Applicant argues that Corlew et al. fail to disclose permanent binding of the sheet.

In response to applicant's arguments, the recitation "for permanent binding" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

It is noted that the arguments with respect to claims 17 and 18 are moot in view of applicant's amendment to claim 2.

For the reasons set forth above, the rejections are maintained.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

mc
July 17, 2002


A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700